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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,827	05/25/2001	Douglas Simpson	ClaimsPlace	7658
7590	01/19/2006		EXAMINER	
Arthur L. Plevy, Esq. Duane, Morris & Heckscher LLP 100 College Road West, Suite 100 Princeton, NJ 08540				KOPPIKAR, VIVEK D
		ART UNIT	PAPER NUMBER	3626

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/865,827	SIMPSON ET AL.	
	Examiner	Art Unit	
	Vivek D. Koppikar	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 01 June 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-44 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 9/26/01 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/25/01</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

1. Claims 1-44 have been examined in this application. The Information Disclosure Statement (IDS) statement filed on May 25, 2001 has also been acknowledged.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being unpatentable by US Patent Number 4,831,526 to Luchs.

(A) As per claim 1, Luchs teaches a method of fulfilling needs of a person or entity acquired as a result of property and other similar losses (Luchs: abstract), the method comprising the steps of:

directing a person or entity with a need resulting from a loss to a site on a global computer network (Col. 6, Ln. 13-Ln. 44; Col. 15, Ln. 46-62);

interviewing the person or entity at the site to obtain information about the person or entity and the need they have (Col. 15, Ln. 45-68); and

analyzing and processing the information to provide the person or entity automatic access at the site to at least one service that will go toward fulfilling the need of the person or entity (Col. 16, Ln. 13-29).

(B) As per claim 2, Luchs teaches a system for fulfilling needs of a person or entity acquired as a result of property and other similar losses (Luchs: abstract), the system comprising a site on

a global computer network for fulfilling needs of persons or entities acquired from property and other similar losses (Col. 6, Ln. 13-Ln. 44; Col. 15, Ln. 46-62), the site including an interviewing component for obtaining information about the person or entity and the need they have (Col. 15, Ln. 45-68), and a data analyzing and processing component for analyzing the information provided by the person or entity and providing the person or entity automatic access at the site to at least one service that will go toward fulfilling the need of the person or entity (Col. 15, Ln. 45-68).

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 3-15 and 25-36 are rejected under 35 U.S.C. 102(b) as being unpatentable by over US Patent Number 5,950,169 to Borghesi.

(A) As per claim 3, Borghesi teaches a computer system for fulfilling needs resulting from claims for losses to person or property (Borghesi: abstract), the system comprising:

a site generating component for generating a site on a global computer network for inputting insurance claims from a plurality of sources (Col. 5, Ln. 51-Col. 6, Ln. 14);
a claim data analyzing component for analyzing the inputted insurance claim using deep domain knowledge about claim processing (Col. 13, Ln. 12-41);

a claim rehabilitation component that aggregates services and products related to loss recovery and uses network market-making tools to provide services to consumers and commercial interests which go toward rehabilitating insurance claims (Col. 4, Ln. 37-63).

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- (B) As per claim 4, in Borghesi the commercial interests include insurers (Col. 4, Ln. 20-36).
- (C) As per claim 5, in Borghesi the site is operative as an online claim reporting hub that permits the plurality of sources to report details of personal and commercial insurance claims against any insurer at any time (Figures 2-3 and Col. 5, Ln. 51-Col. 6, Ln. 5).
- (D) As per claim 6, in Borghesi the plurality of sources include individuals and institutions (Figures 2-3 and Col. 5, Ln. 51-Col. 6, Ln. 5).
- (E) As per claim 7, in Borghesi the personal and commercial insurance claims are selected from the group consisting of automobile claims, homeowners claims and business claims (Col. 2, Ln. 32-37).
- (F) As per claim 8, in Borghesi the site generating component accepts inputs from the global computer network and respond to site users graphically, in sound and in printable forms (Col. 12, Ln. 59-61).
- (G) As per claim 9, in Borghesi the system provides continuous network claim service handling 24 hours a day, 7 day per week (Col. 5, Ln. 51-Col. 6, Ln. 5).
- (H) As per claim 10, in Borghesi the computer system further comprising a privacy preserving component for preserving site users' privacy while online at the site (Col. 15, Ln. 24-33).
- (I) As per claim 11, in Borghesi the plurality of sources is selected from the group consisting of individuals who experienced an insurance loss, entities that anticipate claims against its policies, and witnesses to losses (Figures 2-3 and Col. 5, Ln.51-Col. 6, Ln. 5).
- (J) As per claim 12, in Borghesi the plurality of sources is selected from the group consisting of consumers, policy holders, insurance companies, potentially responsible parties to a lawsuit,

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and persons reporting claim events whose specific roles have not yet been defined (Col. 4, Ln. 19-36).

(K) As per claim 13, in Borghesi the system is adapted to permit consumers to process their own claims and utilize offered ancillary services and commodities (Col. 4, Ln. 19-Ln. 63 and Col. 5, Ln. 5-50).

(L) As per claim 14, in Borghesi the computer system according to claim 3, wherein the system is adapted to permit claim processing without an agent, broker or an insurance company (Figure 3 and Col. 5, Ln. 51-Col. 6, Ln. 5).

(M) As per claim 15, in Borghesi the site is operative as an online consumer-to-business exchange that permits vendors of goods and services to advertise and offer products that individuals and businesses require to rehabilitate a loss (Col. 5, Ln. 5-50).

(N) As per claim 25, Borghesi teaches a method for fulfilling needs resulting from claims for losses to person or property (Borghesi: abstract), the method comprising the steps of:

generating a site on a global computer network for inputting insurance claims from a plurality of sources (Col. 5, Ln. 51-Col. 6, Ln. 14);

analyzing the inputted insurance claim using deep domain knowledge about claim processing (Col. 13, Ln. 12-41);

aggregating services and products related to loss recovery using network market-making tools to provide services to consumers and commercial interests which go toward rehabilitating insurance claims (Col. 4, Ln. 37-63).

(O) As per claim 26, in Borghesi the commercial interests include insurers (Col. 4, Ln. 20-36).

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(P) As per claim 27, wherein the site is operative as an online claim reporting hub that permits the plurality of sources to report details of personal and commercial insurance claims against any insurer at any time (Figures 2-3 and Col. 5, Ln. 51-Col. 6, Ln. 5).

(Q) As per claim 28, The method according to claim 27, wherein the plurality of sources include individuals and institutions (Figures 2-3 and Col. 5, Ln. 51-Col. 6, Ln. 5).

(R) As per claim 29, in Borghesi the personal and commercial insurance claims are selected from the group consisting of automobile claims, homeowners claims and business claims (Col. 2, Ln. 32-37).

(S) As per claim 30, in Borghesi the site generating step includes accepting inputs from the global computer network and responding to site users graphically, in sound and in printable forms (Col. 12, Ln. 59-61).

(T) As per claim 31, in Borghesi the site generating step includes providing continuous network claim service handling 24 hours a day, 7 day per week (Col. 5, Ln. 51-Col. 6, Ln. 5).

(U) As per claim 32, Borghesi teaches further the step of preserving site users' privacy while online at the site (Col. 15, Ln. 24-33).

(V) As per claim 33, in Borghesi the plurality of sources is selected from the group consisting of individuals who experienced an insurance loss, entities that anticipate claims against its policies, and witnesses to losses (Figures 2-3 and Col. 5, Ln. 51-Col. 6, Ln. 5).

(W) As per claim 34, in Borghesi the plurality of sources is selected from the group consisting of consumers, policy holders, insurance companies, potentially responsible parties to a lawsuit, and persons reporting claim events whose specific roles have not yet been defined (Col. 4, Ln. 19-36)

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- (X) As per claim 35, in Borghesi the site is operative as an online consumer-to-business exchange that permits vendors of goods and services to advertise and offer products that individuals and businesses require to rehabilitate a loss (Col. 5, Ln. 5-50).
- (Y) As per claim 36, in Borghesi the aggregating step includes suggesting multiple vendors and services for performing tasks and requirements associated with rehabilitating a claim (Col. 5, Ln. 5-50).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi as applied to Claim 3 above and in further view of Progressive.com (March 1, 2000).

(A) As per claim 16, Borghesi does not teach multiple vendors and services for performing tasks and requirements associated with rehabilitating a claim, however, this feature is well known in the art as evidenced by Progressive.com (Page 1). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the system of Borghesi and add the aforementioned feature from Progressive.com with the motivation of providing a user with a means of comparing insurance policies before making a purchase, as recited in Progressive.com (Page 1).

8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi as applied to Claim 3 above and in further view of US Patent Number 5,704,045 to King.

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(A) As per claim 17, Borghesi does not teach that the site is operative as an online business-to-business exchange where sellers, market makers and investors transact for wholesale claims, post-accident purchase and sale of tranches of risk obligations, and subrogation rights, however, this feature is well-known in the art as evidenced by King (Col. 14, Ln. 42-58). At the time of the invention, one of ordinary skill it would have been obvious for one of ordinary skill in the art to have modified the system of Borghesi with the aforementioned feature from King with the motivation of providing a means for investors to provide funds to support risk, as recited in King (Col. 14, Ln. 42-45).

9. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi in view of King as applied to Claim 17 above and in further view of US Patent Number 5,655,085 to Ryan.

(A) As per claims 18-19, Borghesi in view of King does not teach an automatic claim scoring and valuing component for automatically scoring a claim to determine the likelihood of recovery and valuing a claim. Borghesi in view of King also does not teach the feature whereby the automatic claim scoring and valuing component values a claim's subrogation value by reviewing criteria including accident description, loss state, and responsible party and then assigns a subrogation value to the claim; however, the aforementioned features are well known in the art as evidenced by Ryan (Col. 1, Ln. 38-51). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined system of Borghesi in view of King with the aforementioned teachings from Ryan with the motivation of providing a means for the subrogation rights purchasers to automatically determine which product provides the best value, as recited in Ryan (Col. 1, Ln. 45-49).

10. Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi in view of King and Ryan as applied to Claim 19 above and in further view of US Patent Number 5,307,262 to Ertel.

(A) As per claims 20-21, the combined system of Borghesi in view of King and Ryan do not teach a claim bundling component that bundles the scored and claimed values into a group of claims that have commonality to the claim. The combined system of Borghesi in view of King and Ryan also does not teach a sale price determining component for determining a sale price for the bundled group of claims, however, the aforementioned features are well known in the art as evidenced by Ertel (Col. 5, Ln. 20-39 and Col. 29, Ln. 11-48). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined system of Borghesi in view of King and Ryan with the aforementioned feature from Ertel with the motivation of facilitating the generation of a wide variety of useful summary reports, as recited in Ertel (Col. 29, Ln. 25-28).

11. Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi as applied to Claim 3 above and in further view of US Patent Number 6,453,297 to Burks.

(A) Borghesi does not teach a database which permits selected users to search for similar Claims (identify data patterns), thereby enabling the selected users to identify potential claims which are likely to develop as class action suits or mass tort claims. Borghesi also does not teach an identity concealment component (generic data format) for concealing the identities of claimants of the claims when searching for similar claims in the database, however, the aforementioned features are well known in the art as evidenced by Burks (Col. 16, Ln. 34-46). At the time of the invention, it would have been obvious for one of ordinary skill in the art to

have modified the system of Borghesi with the aforementioned feature from Burks with the motivation of providing a user with a means of containing insurance costs, as recited in Burks (Col. 16, Ln. 42-45).

12. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combined system of Borghesi in view of Burks and in further view of Ertel.

(A) The combined system of Borghesi in view of Burks also does not teach a sale price determining component for determining a sale price for the bundled group of claims, however, the aforementioned features are well known in the art as evidenced by Ertel (Col. 5, Ln. 20-39 and Col. 29, Ln. 11-48). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined system of Borghesi in view of King and Ryan with the aforementioned feature from Ertel with the motivation of facilitating the generation of a wide variety of useful summary reports, as recited in Ertel (Col. 29, Ln. 25-28).

13. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi as applied to Claim 25 above and in further view of US Patent Number 5,704,045 to King.

(A) As per claim 27, Borghesi does not teach that the site is operative as an online business-to-business exchange where sellers, market makers and investors transact for wholesale claims, post-accident purchase and sale of tranches of risk obligations, and subrogation rights, however, this feature is well-known in the art as evidenced by King (Col. 14, Ln. 42-58). At the time of the invention, one of ordinary skill it would have been obvious for one of ordinary skill in the art to have modified the method of Borghesi with the aforementioned feature from King with the motivation of providing a means for investors to provide funds to support risk, as recited in King (Col. 14, Ln. 42-45).

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14. Claims 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi in view of King as applied to Claim 37 above and in further view of US Patent Number 5,655,085 to Ryan.

(A) As per claims 38-39, Borghesi in view of King does not teach an automatic claim scoring and valuing component for automatically scoring a claim to determine the likelihood of recovery and valuing a claim. Borghesi in view of King also does not teach the feature whereby the automatic claim scoring and valuing component values a claim's subrogation value by reviewing criteria including accident description, loss state, and responsible party and then assigns a subrogation value to the claim; however, the aforementioned features are well known in the art as evidenced by Ryan (Col. 1, Ln. 38-51). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined method of Borghesi in view of King with the aforementioned teachings from Ryan with the motivation of providing a means for the subrogation rights purchasers to automatically determine which product provides the best value, as recited in Ryan (Col. 1, Ln. 45-49).

15. Claims 40-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi in view of King and Ryan as applied to Claim 39 above and in further view of US Patent Number 5,307,262 to Ertel.

(A) As per claims 40-44, the combined system of Borghesi in view of King and Ryan do not teach a claim bundling component that bundles the scored and claimed values into a group of claims that have commonality to the claim. The combined method of Borghesi in view of King and Ryan does not teach a sale price determining component for determining a sale price for the bundled group of claims. The combined method of Borghesi in view of King and Ryan does

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not teach a step of providing a database and permitting selected users to search for similar claims, thereby enabling the selected users to identify potential claims which are likely to develop as class action suits or mass tort claims. The combined method of Borghesi in view of King and Ryan also does not teach the step of concealing the identities of the claimants of the claims during the claim searching step nor the step of pooling common issues into anonymous class action groups , however, the aforementioned features are well known in the art as evidenced by Ertel (Col. 5, Ln. 20-39 and Col. 29, Ln. 11-48). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined method of Borghesi in view of King and Ryan with the aforementioned feature from Ertel with the motivation of facilitating the generation of a wide variety of useful summary reports, as recited in Ertel (Col. 29, Ln. 25-28).

Conclusion

16. Any inquire concerning this communication or earlier communications from the examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-5109. The examiner can normally be reached from Monday to Friday between 8 AM and 4:30 PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Another resource that is available is the Patent Application Information Retrieval (PAIR). Information regarding the status of an application can be obtained from the (PAIR) system. Status information for published applications may be obtained from either Private PAIR or

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Public PAX. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please feel free to contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,


Vivek Koppikar

9/22/2005


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER